

## **Remarks**

### **Amendments to the Claims**

Upon entry of the foregoing amendment, claims 1, 3-5, 7-23, 27-30 are pending in the application. Of the pending claims, claims 1, 27 and 30 are independent.

The Examiner has rejected claims 24, 26 as being either anticipated by Pekar and has rejected claims 1, 3-5, 8, 13-14, and 16-23 as being obvious in view of Pekar as modified by the cited prior art. The device of Pekar discloses an inflatable multi-layer support having vertically stacked upper and lower chamber portions. The hourglass configuration of the Pekar device is in contrast to what is required by the claims. All of the claims require a plurality of ribs extending between the top and the bottom of one of the first and second compartments. Absent impermissible hindsight, there is no motivation to modify the device of Pekar to include a similar limitation of ribs in one of the compartments.

The examiner has also rejected claims 1, 6-7, 9-12, 15, 27 and 30 as being obvious over Wolfe in view of Cook. As noted by the examiner, Wolfe fails to disclose that the first and second compartments are secured together adjacent a fluid communication channel, wherein the fluid communication channel provides fluid communication between the first and second inflatable compartments to enable fluid in one of the compartments to flow in to the other. The examiner states that it would have been obvious to add a similar fluid communication channel that is shown in Cook to the device of Wolfe. The applicant disagrees for the reasons set forth below.

1. There is no motivation to combine Wolfe and Cook

Wolfe is an air mattress. Cook is a low loss air mattress requiring a constant influx of air to remain inflated. The examiner states that it would have been obvious to make the suggested modification in order to allow for "a smaller less expensive compressor" in order to "maintain the low air loss of the smaller upper layer". However, this ignores the fact that Wolfe did not require a compressor in the first place. A compressor is not needed until the suggested modification of adding the one way valves between the first and second compartments and adding low loss holes to the mattress of Wolfe to allow the differences in firmness desired by Wolfe. There can be no motivation for a modification of the simple structure of Wolfe (separate inflatable compartments) to include the compressor, one way valves, and relief holes of cook. Accordingly, the modification of Wolfe suggested by the examiner lacks the motivation necessary for such a change. Absent such a reason, the only justification for the suggested modification is one based upon impermissible hindsight. As stated in the case of *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992):

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, (Fed. Cir. 1990).

**Conclusion**

There is no motivation for the suggested modification. Accordingly, Applicant respectfully submits that independent claims 1, 27 and 30 are allowable over the prior

art of record. For similar reasons, Applicants urge that the dependent claims are also allowable.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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